

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:	KARER ET AL.	DOCKET No.:	0775/000003
SERIAL No.:	09/700,367	CONFIRMATION No.:	6131
FILING DATE:	11/15/2000	EXAMINER:	NECKEL, ALEXA DOROSHENK
CUSTOMER No.:	26474	ART UNIT:	1764

FOR: GAS-PHASE FLUIDIZED-BED REACTOR

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

PETITION UNDER 37 C.F.R. § 1.181

Statement of the facts involved: in response to the non-final office action of April 17, 2006, applicants filed a reply including amendments to the claims. In the subsequent Office action of September 29, 2006, the examiner presented new grounds for rejection and made the action final.

Point to be reviewed: whether the examiner erred in making the Office action of September 29, 2006 final.

Action requested: withdraw the finality of the Office action of September 29, 2006.

Remarks: “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).”¹

First, the rejections were not based on information submitted in an IDS filed during the period set forth in 37 C.F.R. §1.97(c); the new rejections were based on **Giovoni et al. (USPN 6,413,477)**, which was cited by the examiner in the Office action of January 26, 2005. Second, the new grounds of rejection were not necessitated by the amendments because the claims were amended to include limitations which should reasonably have been expected to be claimed. The amendments to claim 1 constituted a mere rewording which did not alter the scope or content of the claim. New claim 16 is identical to claim 1 prior to the amendments to claim 1. New claims 17 – 23 all depend from new claim 16. Thus, the amendments to claims 1 and 16 constitute no change which would have

¹ MPEP §706.07(a)

necessitated the new ground for rejection. Claims 17 – 23 merely include limitations which should have reasonably been expected to be claimed. Therefore, the amendments did not necessitate the new grounds for rejection.

“Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.”² It is respectfully submitted that the applicant has not “dallied in the prosecution of [this] application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner ...”³ However, the examiner has switched grounds of rejection from one set of references to another in successive actions regarding claims of substantially the same subject matter.

For at least these reasons, it is respectfully submitted that the examiner erred in making the Office action of September 29, 2006 final. Withdrawal of the finality of the Office action of September 29, 2006 is solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account 14.1437. Please credit any excess fees to such account.

Respectfully submitted,
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² MPEP §706.07.

³ MPEP §706.07.